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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/910,980	08/07/1997	THOMAS D. PETITE	81607-1012	3165
7590	11/30/2004		EXAMINER	
Troutman Sanders LLP Bank of America Plaza 600 Peachtree Street, NE Suite 5200 Atlanta, GA 30308-2216			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/910,980	PETITE, THOMAS D.
Examiner	Art Unit	
Ahshik Kim	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10/6/03 (Appeal Brief).

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 17-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 17-36 is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 23 April 1999 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Appeal Brief*

1. Receipt is acknowledged of the Appeal Brief filed on October 6, 2003.

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### *Finality Withdrawn*

2. In careful review of the Appellant's appeal brief, especially the summary of invention and subsequent argument section, the finality of the office action (mailed on July 21, 2003) is withdrawn.

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### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

15 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Parienti (US 5,189,287, hereinafter “Parienti”).

20 Re claims 26, Parienti teaches a system for transmitting billing information (col. 3, lines 49+) comprising a portable remote access unit 1 which communicates with a terminal 11 via infrared (col. 3, lines 12+). As further described (see abstract; col. 2, lines 18+), the portable unit contains memory area to retain permanent data relating to the user. The unit further contains an alphanumeric keyboard 4, and a display screen (col. 2, lines 35+) will guide them for various

transactions. Although Parienti does not explicitly suggest of a transmit button, the unit 1 is capable of transmitting and receiving the data from the host or exchange data with other portable units (col. 4, lines 1-30). The portable unit, the host, and other component parts of the system are equipped with necessary software to execute assigned tasks. For example, the device should contain card-reading software, infrared transmission software, keyboard software, etc.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15 6. Claims 17-25, 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parienti (US 5,189,287). The teachings of Parienti have been discussed above.

Re claims 17, 20, 23, 27, 30, 32, and 34-36, Parienti fails to specifically teach of fairly suggest that the remote device is further comprised of a manually-operated button for initiating a 20 transmission of data.

As indicated in paragraph 4 above, the remote unit of Parienti clearly discloses a data transmitting component (see figures 6A, 6B and 8; col. 2, lines 6+). It is also discloses that the remote unit allows the users to enter desired data and transmit it to the central processing center or other recipient (col. 4, lines 50+). In order to allow the users to enter necessary data and then 25 transmit them for processing, it is obvious that the terminal should be equipped with some means for indicating "data entry" phase and "completion of data entry". In many devices, the key such

as "enter" or "send" or "transmit" would transmit entered data up to that point. Until such key is pressed, the users can readily enter data or change data as desired. Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to provide the users with means to distinguish data entry phase and transmit phase. Often they are achieved by use of 5 a key, button or switch with directions.

Re claims 18 and 19, in the embodiment wherein the unit is used as a payment terminal (see figure 5, col. 3, lines 49+), the unit contains an identification data, which may be a bank account number, credit card number or long distance billing account number.

Re claims 22 and 33, although Parienti is silent on formatting data or structure of the data 10 packet, in order to initiate and fulfill payment or other type of transaction, it is inherent that data being transmitted contains all necessary parts (i.e., identification information, transactional information, payment information, etc.) for the financial institutions to approve/disapprove transactions.

Re claim 24, the communication between a portable terminal and the host can be 15 achieved utilizing a telephone line (see abstract; col. 1, lines 16+).

Re claim 25, as illustrated in figure 6A and 6B, one can reasonably suggest that the distance between the terminal 11 and the portable unit 1 is within several feet.

Re claim 31, as shown in figure 5, a bank card (magnetic card) 15 can be used with the portable unit.

20 7. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parienti (US 5,189,287) in view of Tait et al. (US 5,550,358). The teachings of Parienti have been discussed above.

Although a conventional credit card transaction and bank card transaction disclosed in Parienti (col. 3, lines 49+) require the users to enter a PIN number, Parienti fails to specifically teach or fairly suggest of authorizing use of the communication device.

Tait teaches a remote wireless transaction system (see abstract), which allows transaction 5 to proceed (and in turn the use of the device) only after user-provided PIN number is verified (see abstract; col. 2, lines 17). Tait also teaches wireless communication utilizes radio frequency signal (col. 3, lines 30+) as recited in claim 29.

In view of Tait's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ notoriously old and well-known PIN number or other 10 means of user verification (i.e., password, biometric verification) to the teachings of Parienti in order to ensure that user-sensitive information can only be used after verifying authenticity of the user. Such layer of protection or user authentication is well known in the art, and widely used in various embodiments. Since the transaction can proceed only after successful verification, use of the transaction device is not permitted if such authentication process fails. As further suggested 15 by Tait, use of infrared or radio frequency can be considered functionally equivalent to one ordinary skill in the art.

#### ***Additional Remarks***

8. Appellant's appeal brief filed on October 6, 2003 have been carefully considered. Prior 20 actions and responses between the Appellant and the Examiner are also reviewed. It appears that Applicant's main argument hinges on "manually-operated transmit button". It is the Examiner's view that the Parienti patent does have data transmitting functionality. In view of

Appellant's argument, and review of the Parienti patent, the basis for rejection for some claims was changed from anticipation to obviousness grounds. Accordingly, this Office Action is made non-final.

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### ***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Mazza et al. (US 4,436,957); Dent et al. (US 5,282,250) disclose a remote device accessing communication device. Applicant is respectfully suggested to carefully review these references.

10 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

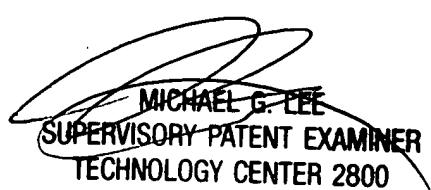
25 All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

30 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
November 22, 2004

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